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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,802	06/11/2001	Gad Friedman	LUZZATTO-086	3752

7590

09/27/2002

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/27/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,802

Applicant(s)

FRIEDMAN ET AL.

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on JULY 16, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- ☐ Of the above claim(s) 16-25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-25 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Claims 16-25 are ^{has} withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected inventions. Election was made without traverse in Paper No. 6.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 7-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over ^GMcLaughlin et al. 5,948,323 in view of ^FFishler et al. 5,072,028. McLaughlin et al. (Example 2 referring to Example 1; and Example 5) disclose aqueous dispersions of flame retardant material such as antimony trioxide and decabromodiphenyl oxide and their preparation by milling to obtain a desired particle size e.g. 0.11 micron or 0.25 micron, noting that in Example 2 the milling is conducted in the presence of Tamol -SN (a sodium salt of condensed naphthalene sulfonate) and Triton CF-10 (an alkylaryl polyether). As to particle size, attention is also directed to McLaughlin et al. (column 2, lines 51-65). While McLaughlin et al. do not disclose pentabromobenzyl acrylate (PBBMA), it would have been obvious to one skilled in

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the art at the time applicants' invention was made to add the PBBMA of Fishler et al. Example 1 to the starting materials in Example 2 of McLaughlin et al. to obtain an aqueous dispersion in which the PBBMA imparts its outstanding flame retardant properties (Fishler et al. - column 2, lines 3-7). *See, e.g., U.S. Pat. 2,851,517 (Kopelman) 1959* As to claims 7-9 herein, the stability stated therein would be inferred from McLaughlin et al. (column 2, lines 40-43). As to claims 10 and 11 herein, it would further have been obvious to one skilled in the art at the time applicants' invention was made to incorporate Triton X-100 (McLaughlin et al. - column 5, lines 8-33) in the aqueous dispersions of McLaughlin et al., modified as above by Fishler et al., under the doctrine of In re Crockett et al. 279 F. 2d 274, 126 USPQ 186. Thus, where the prior art of record teaches the use of each of two additives individually; assuming that the two together produce an effect somewhat greater than the sum of their separate effects, the idea of combining them would flow logically from the teaching of the prior art; therefore, claims to their joint use are not patentable.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Fishler et al. as applied to claims 1-5 and 7-12 above, and further in view of Strickland 4,822,524. While the above combination of McLaughlin et al. and Fishler et al. may not disclose the use of xanthan gum, it would further have been obvious to one skilled in the art

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at the time applicants' invention was made to add the xanthan gum of Strickland to the starting materials in Example 2 of McLaughlin et al., modified as above by Fishler et al., to realize the improvement(s) made apparent by Strickland (paragraph bridging columns 2 and 3, esp. column 3, lines 11-13).

5. Claim 15 is rejected ^{by} under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Fishler et al. as applied to claims 1-5 and 7-12 above, and further in view of ^A Gilcrease et al. 2,662,061. While the above combination of McLaughlin et al. and Fishler et al. may not disclose the use of a stabilizer or antioxidant, it would further have been obvious to one skilled in the art at the time applicants' invention was made to add e.g. hydroquinone monobenzyl ether of Gilcrease et al. (column 1, lines 7-24, esp. line 23) to the starting materials in Example 2 of McLaughlin et al. modified as above by Fishler et al. The use of a known additive for its known function lacks patentable significance. See ^{the} ~~In re Sussman~~, 554 O.G. 17, 1943 ^{and Kerkover, disc. cited above}

~~C.D. 518.~~

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 10, 11, 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing ^{See in p. 13514}

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to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claims 1 and 11 recite Markush groups which are not considered proper for the reasons that they are indefinite as to scope and incomplete as to their memberships in not reciting --and-- between the penultimate and last members (claim 1) and in using "or" instead of --and-- (claim 11);

b) claim 1 is indefinite in reciting "type" (last line), because the addition of the word "type" to an otherwise definite expression extends the scope thereof so as to render it indefinite. Ex parte Copenhaver, 109 USPQ 118;

c) claims ~~10~~ and 11 are indefinite as to scope as to the number of ingredients, since independent claim 1 itself calls for nonionic and/or anionic surfactants;

d) claim 2 is indefinite in lacking antecedent basis in claim 1 for "alkyl naphthalene sulfonates or their sodium salts"; and

e) claims 13 and 14 are indefinite as to scope in "an additional compound", since the metes and bounds of the quoted expression are not clear. Also applicants disclose only fire-retardant synergists (specification page 4, paragraph 0026).

8. In claim 1 line 4, and in claim 6, line 3, "xanthene" should be changed to --xanthan--; and in claim 10, line 3, "comprise" should be changed to --comprises--.

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rebuttal to RPL

9. Claims 13 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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10. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the processes of claims 13 and 14 herein in which an aqueous PBBMA suspension is prepared by grinding in water containing wetting agents and then mixed with a similarly prepared suspension of an additional compound.

PTO-1449
11. The remaining references listed on the attached Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
September 25, 2002

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1200/1700